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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,532	08/01/2001	Takayuki Yamamoto	Q65685	3507

7590

08/06/2003

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS9

Advisory Action	Application No. 09/918,532	Applicant(s) YAMAMOTO ET AL.	
	Examiner Tatyana Zalukaeva	Art Unit 1713	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-10.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

8/4/03


 Tatyana Zalukaeva
 Primary Examiner
 Art Unit: 1713

Continuation of 2. NOTE: Applicants' proposed amendment in the independent claim 1 limits the resulting product of the claimed process for only high molecular fractions by stating that 10% or less are having a molecular weight of 100,000. If entered, this would require new search and consideration, and even at first glance would have been rejected under 35 USC 112, second paragraph, as being indefinite to point out whether the "number average" or the "weight average" molecular weight is meant. New claims 11 and 12 also require new search and consideration, since they further limit the range of lower molecular weight fractions in a resulting process. .

Continuation of 5. does NOT place the application in condition for allowance because: The issue of "Molecular weight" that can be weight average, number average, and viscosity based are discussed in previous Office actions and is incorporated herein in its entirety. .

The molecular weight limitations set forth in proposed amendment fails to identify whether this numerical value represents a weight average or a number average molecular weight determination. It is imperative that the method utilized to determine molecular weight or the "weight" or number" be identified, since it is well known that different methods of determining molecular weight of a particular polymer yield significantly different numerical values. Therefore, if entered, claims do not set out and circumscribe a particular area with a reasonable degree of precision and particularity.

Applicants' argument on the art rejection is based partially or entirely on the limitations of proposed amendment that has not been entered

Tatyana Zalukaeva, Ph.D.
Primary Examiner
Art Unit 1713

